

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY B. McBRIDE

Appeal No. 97-1977
Application 07/970,862¹

HEARD: July 18, 1997

Before COHEN, LYDDANE and FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

¹ Application for patent filed November 3, 1992. According to appellant, the application is a continuation of Application 07/606,624, filed October 31, 1990, now U.S. Patent 5,178,311, issued January 12, 1993.

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DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 32 through 36, 38, 40 through 45 and 47 through 52 as amended subsequent to the final rejection in a paper filed April 16, 1996 (Paper No. 22). The above enumerated claims are all of the claims remaining in this application. Claims 1 through 31, 37, 39 and 46 have been canceled.

Appellant's invention relates to a method of carrying and reading a map (claim 32), more particularly, a method of carrying and reading a ski area trail map by a skier (claim 41). Claim 32 is representative of the subject matter on appeal and a copy of that claim, as it appears in the Appendix to appellant's brief, is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Connell et al. (Connell)	4,415,106	Nov. 15, 1983
Williams	4,570,688	Feb. 18, 1986

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Claims 32 through 36, 38, 40 through 45 and 47 through 52 stand rejected under 35 U.S.C. § 103 as being unpatentable over Williams in view of Connell.

Rather than reiterate the examiner's full explanation of the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellant regarding that rejection, we make reference to the examiner's answer (Paper No. 27, mailed August 26, 1996) and supplemental answer (Paper No. 30, mailed December 17, 1996) for the examiner's complete reasoning in support of the rejection, and to appellant's brief (Paper No. 26, filed June 11, 1996) and reply brief (Paper No. 28, filed October 17, 1996) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination that the examiner's

rejection of the appealed claims under 35 U.S.C. § 103 cannot be sustained. Our reasoning for such determination follows.

As has been observed by the examiner, Williams discloses a device which may be broadly viewed as a neck supported printed matter display holder. More particularly, Williams describes the article therein as a security wallet (10) that is secured to an elongated cord (11) which is intended to be worn over the user's neck or shoulder, as generally depicted in Figure 1 of the patent drawings. Williams indicates (col. 2, line 67 et seq.) that the security wallet may be concealed beneath a person's coat or jacket, or alternatively may be slipped under the wearer's shirt for maximum security. The examiner notes that Williams includes a pocket (40) inside the wallet which has a transparent window (38) and that this pocket is used for carrying documentation that must be displayed from time to time (col. 6, lines 3-7).

On pages 4-5 of the answer, the examiner has taken the position that while the Williams patent is described in terms of the apparatus, the steps involved to take the device from its

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hidden location "are inherent from the disclosure." In this regard, the examiner has also indicated (answer, page 3) that

[t]he removing and opening of the holder of Williams is considered to be done in a "single maneuver" to the extent this is defined in the claims as the Williams device is closed by loop and hook fasteners which allow easy opening of the holder.

The examiner next discusses the Connell patent, urging that it discloses another type of holder, specifically one used by a skier, wherein a ski trail map may be placed in the holder in order that it may be viewed from time to time. Based on the collective teachings of Williams and Connell, the examiner concludes that

[i]t would have been obvious [to one of ordinary skill in the art] to place a ski map in the transparent pocket (40) of Williams in view of the teachings of Connell et al. in order for the active person to view a ski map from time to time (answer, pages 3-4).

After reviewing the applied Williams and Connell patents and the respective positions of the examiner and appellant, we must agree with appellant's position that the examiner has failed to establish a prima facie case of

obviousness of the claimed method defined in appellant's claims 32 through 36, 38, 40 through 45 and 47 through 52. Contrary to the examiner's view, we fail to perceive any teaching, suggestion or incentive in the patents relied upon which would have motivated one of ordinary skill in the art to use the security wallet of Williams for carrying and reading of a map in the particular manner urged by the examiner.

Connell addresses the problem (col. 1, lines 44-56) of carrying a ski area trail map in zippered or otherwise sealable pockets of ski apparel and the need for the skier to remove heavily insulated gloves or mittens and ski poles before being able to retrieve the map from such a pocket when stopping to make certain of one's location or the location of a desired trail. As noted in column 1, lines 59-65, of Connell, the invention in the patent was developed specifically as a solution to the above-noted problem and allows a skier to

have instantly available a ski area map for convenient reference without requiring that ski poles be unstrapped from ski mittens, ski mittens be removed from hands, a ski pocket be unzipped, cold hands be required to hold a map for reference, and the reverse sequence of activities be repeated before skiing can be recommenced.

Objects of the invention in Connell, set forth in column 2, lines 5-16, indicate that the invention therein will relieve a skier from the inconvenience of having to retrieve a map from a zippered pocket and will provide a map holder whose position on a skier's exterior clothing is maintained by friction to keep it in full view at all times.

It is apparent from the foregoing that a paramount consideration in Connell is that the ski area trail map not be carried in a zippered or otherwise sealable pocket of the user's ski apparel and that the map holder be positioned on the skier, or the skier's exterior clothing, so that it is "instantly available" and so that it is "in full view at all times." Given the importance of this aspect of the Connell invention, we do not share the examiner's view that it would have been obvious to one of ordinary skill in the art to place a ski map in the transparent pocket (40) of Williams "in view of the teachings of Connell." The pocket (40) of Williams is on the interior of the foldable security wallet and is thus enclosed within the wallet when the wallet is folded, as seen in Figures 2-3, with the

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fastening material bands of VELCRO (75, 76) of the wallet engaged. As urged by appellant, this type of enclosure of a ski map within a sealable carrying device which must be opened before the map can be consulted by a skier would be totally contrary to the teachings of Connell.

As a further point, even if a map were to be carried in the pocket (40) of the security wallet of Williams, we do not share the examiner's view that the "inherent use" of Williams meets the limitations of appellant's claims on appeal. We see nothing in the teachings of Williams which would have been suggestive to one of ordinary skill in the art of using the security wallet of Williams in the particular manner required in appellant's claims on appeal. Like appellant, we are of the view that the examiner has relied upon impermissible hindsight to arrive at the present determination of obviousness. For this reason, the examiner's rejection of claims 32 through 36, 38, 40 through 45 and 47 through 52 under 35 U.S.C. § 103 as being unpatentable over Williams in view of Connell will not be sustained.

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The decision of the examiner is, accordingly, reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
WILLIAM E. LYDDANE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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CHARLES E. FRANKFORT)	
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APPENDIX

32. A method of carrying and reading a map, comprising the steps of:

placing a holder containing the map around the neck of a person, said holder including (1) a neck-surrounding member to be removably retained around the neck of the person; and (2) a map supporting member, for supporting the map, such that the map is exposed, in the supporting member, to be read by said person, said supporting member being attached to and held by said neck-surrounding member, said neck-surrounding member achieving a sufficient length such that the map contained by the supporting member can be read by said person around whose neck the holder is placed, without the neck-surrounding member having to be removed from the person's neck, the holder being placed such that the neck-surrounding member is located around the neck of said person, with the supporting member tucked away in a protected and non-visible location to prevent damage to the map from exposure to adverse conditions;

grabbing the holder, removing the supporting member from said protected and non-visible location, and positioning the supporting member so that the map can be read by the person around whose neck the holder is placed, in a single maneuver, while the neck-surrounding member is maintained around the neck of the person, said grabbing, said removing and said positioning being performed by said person; and

reading the map by the person around whose neck the holder is placed, while the neck-surrounding member is maintained around the neck of the person and the map is maintained in the supporting member, so that the map is read without removing the neck-surrounding member from around the neck of the person, the supporting member being maintained in its protected and non-visible location and removed therefrom, positioned so that the map can be read by the person, and the map is read by the person, all without removing the neck-surrounding member from around the neck of the person.